

Group II, claims 8 and 16, drawn to a method of preparing aminoxy-cyclodextrin derivatives;

Group III, claims 10 and 12 (when acetone oxime derivative is selected), drawn to oximes of aminoxy-cyclodextrin derivatives; and

Group IV, claims 11 and 15, drawn to derivatives of nucleotide or nucleoside pyrimidines or purines with aminoxy-cyclodextrins.

For the purpose of examination of the present application, Applicants elect, with traverse, Group I, claims 1-7 and 12-14.

Applicants submit the following arguments in response to the Examiner's revised Restriction Requirement. As Applicants pointed in the first Reply to Restriction Requirement filed on November 15, 2002, where the Examiner used an incorrect standard for evaluating unity of invention, Applicants submitted that Groups I and III should be reunited at the very least according to the guidelines promulgated in PCT Administrative Instructions Annex B, Part 2, "Examples Concerning Unity of Invention" (another copy is attached hereto for the Examiner's convenience).

The compound of Group I differs from the compound of Group III by having different substituents on the common structure. Applicants submit that when claims differ in this manner, unity of invention exists where there is a common structure and the different substituents in the Markush group do not change the utility of the claimed compound. Please see Example 18 for an illustration of such a situation. Applicants submit that Groups I and III are the same as Example 18 in the PCT guidelines. As such, unity of invention surely exists between Groups I and III and the groups should be rejoined.

Furthermore, Group II is directed to a method of making the compound of Group I and III. Please see Example 1 in the PCT guidelines. When a claim is directed to a compound and another claim is directed to making that claimed compound unity of invention exists between the two claims. This is the exact situation between Groups I, II and III. As such, Applicants respectfully request that Groups I, II and III be rejoined for examination in unison.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Kecia Reynolds (Reg. No. 47,021) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

Andrew D. Meikle, #32,868


ADM/KJR:bmp
0933-0160P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

(Rev. 01/02/02)

Attachment: PCT Administrative Instructions Annex B, Part 2,
Examples Concerning Unity of Invention,
Examples 1 and 18

[ANNEX B, CONTINUED]

PART 2

EXAMPLES CONCERNING UNITY OF INVENTION

The application of the principles of unity of invention is illustrated by the following examples for guidance in particular cases.

I. CLAIMS IN DIFFERENT CATEGORIES

Example 1

Claim 1: A method of manufacturing chemical substance X.

Claim 2: Substance X.

Claim 3: The use of substance X as an insecticide.

Unity exists between claims 1, 2 and 3. The special technical feature common to all the claims is substance X.

Example 2

Claim 1: A process of manufacture comprising steps A and B.

Claim 2: Apparatus specifically designed for carrying out step A.

Claim 3: Apparatus specifically designed for carrying out step B.

Unity exists between claims 1 and 2 or between claims 1 and 3. There is no unity between claims 2 and 3 since there exists no common special technical feature between the two claims.

Example 3

Claim 1: A process for painting an article in which the paint contains a new rust inhibiting substance X including the steps of atomizing the paint using compressed air, electrostatically charging the atomized paint using a novel electrode arrangement A and directing the paint to the article.

Claim 2: A paint containing substance X.

Claim 3: An apparatus including electrode arrangement A.

Unity exists between claims 1 and 2 where the common special technical feature is the paint containing substance X or between claims 1 and 3 where the common special technical feature is the electrode arrangement A.

However, unity is lacking between claims 2 and 3 since there exists no common special technical feature between them.

Example 4

Claim 1: Use of a family of compounds X as insecticides.

Claim 2: Compound X_1 belonging to family X.

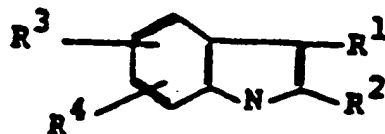
Provided X_1 has the insecticidal activity and the special technical feature in claim 1 is the insecticidal use, unity is present.

Expression of the DNA sequence in a host results in the production of a protein which is determined by the DNA sequence. The protein and the DNA sequence exhibit corresponding special technical features. Unity between claims 1 and 2 is accepted.

III. MARKUSH PRACTICE

Example 18— common structure:

Claim 1: A compound of the formula:

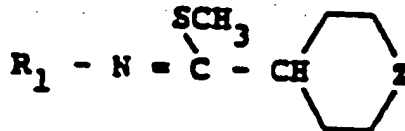


wherein R^1 is selected from the group consisting of phenyl, pyridyl, thiazolyl, triazinyl, alkylthio, alkoxy, and methyl; R^2 - R^4 are methyl, benzyl, or phenyl. The compounds are useful as pharmaceuticals for the purpose of enhancing the capacity of the blood to absorb oxygen.

In this case the indolyl moiety is the significant structural element which is shared by all of the alternatives. Since all the claimed compounds are alleged to possess the same utility, unity is present.

Example 19— common structure:

Claim 1: A compound of the formula:



wherein R_1 is selected from the group consisting of phenyl, pyridyl, thiazolyl, triazinyl, alkylthio, alkoxy, and methyl; Z is selected from the group consisting of oxygen (O), sulfur (S), imino (NH), and methylene ($-\text{CH}_2-$). The compounds are alleged to be useful as pharmaceuticals for relieving lower back pain.

In this particular case the iminothioether group $-\text{N}=\text{C}(\text{SCH}_3)-$ linked to a six atom ring is the significant structural element which is shared by all the alternatives. Thus, since all the claimed compounds are alleged to possess the same use, unity would be present. A six membered heterocyclic ring would not have been of sufficient similarity to allow a Markush grouping exhibiting unity, absent some teaching of equivalence in the prior art.

Example 20— common structure

Claim 1: A compound of the formula:

